

REMARKS:

Applicant (Tadashi MORITA *et al.*) respectfully requests reconsideration and allowance of the claims in this application. Claims 5, 7, 8, 10, and 12 were canceled previously. The foregoing Listing of Claims cancels withdrawn claim 14 and adds new claims 15-26. The correspondence between the new claims and the previous or current claims is set forth in the following table for the Examiner's convenience.

Previous Claims	New Dependent Claim	New Claims	
1		16	22
2		18	23
3		19	24
4		20	25
6		21	26
9			
11			
13			
	15	17	

New claim 15 depends from claim 1 and further defines that the communication period includes a starting date and an ending date, along the lines described in the last paragraph on page 20 of the present specification disclosure, which arrangement is not contemplated or suggested by the teachings cited against Applicant's claims in the outstanding Office Action. New claims 16-21 defined the invention differently than that previously set forth. These claims define the structure of the various components of Applicant's invention including that the server comprises a database having a correspondence between the one terminal and the one construction machine based on the unique and fixed terminal identifier of the one terminal and the unique construction machine information of the one construction machine, which corresponds to the information

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shown in FIG. 4 of the present application. New claim 17 further defines that the database includes separate areas for the unique and fixed terminal identifier and the unique construction machine information such as shown in item 263 of FIG. 4, which arrangement is not contemplated or suggested by the teachings cited against Applicant's claims in the outstanding Office Action. New claims 22-26 include means plus function limitations and have a scope of invention similar to that set forth in claims 1-4, 6, 9, 11, 13 and 15-21.

The outstanding Office Action acknowledged Applicant's election of claims 1-13 without traverse. However, Applicant's response previously filed on January 29, 2007, requested a modification of a restriction requirement, so that claims 1-4, 6, 9, 11, and 13 were examined together and only claim 14 was directed to a non-elected invention. Since the outstanding Office Action provided an action on the merits of claims 1-4, 6, 9, 11, and 13, while only claim 14 was withdrawn from consideration, it appears that the Applicant's request to modify the restriction requirement was approved by the Examiner.

Claims 1, 2, 4, 6, 9, 11, and 13 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action stated that limitations, such as "a user," "the user," and "a new user" do not have improper antecedent basis. These matters are corrected in the foregoing amendments. The Official Action also stated that the expression "...out of a preset range'..." in claims 6, 9, 11, and 13 is vague/unclear. In the foregoing amendments, this expression was changed to read "outside the map." Applicant respectfully submit that claims 1, 2, 4, 6, 9, 11, and 13, as amended above, particularly point out and distinctly claim the subject matter regarded as the invention within the meaning of 35 U.S.C. §112, second paragraph.

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Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

Claims 1-4 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent publication No. 2002/0123840 of Obata *et al.* (Obata) in view of U.S. patent publication No. 2004/0204032 of Hisano *et al.* (Hisano). Claims 6, 9, 11 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Obata in view of Hisano, further in view of U.S. patent No. 4,651,157 of Gray *et al.* (Gray). These rejections were set forth on pages 3-9 of the Official action and include positions similar to those previously set forth. Applicant respectfully submits that the inventions defined in claims 1-4, 6, 9, 11, 13, and 15-26 are patently distinguishable from the teachings of Obata, Hisano, and Gray for at least the following reasons.

As described in the application, the presently claimed invention recognizes the problems caused by charging for use of a communication channel, where the communications are associated with a terminal that can be switched between traveling machines (and hence between entities that should be charged for the communications). See, for example, Applicant's specification p. 1, line 18 – p. 2, line 3; p. 2 lines 18 – 23.

Independent claim 1 recites, for example, “a terminal *having a unique and fixed identifier* and provided on a construction machine; and a server connected to the terminal through a communication channel,” the server “managing construction machine information unique to the construction machine, managing terminal user information unique to a user of the terminal, associating the *unique and fixed identifier* with the terminal, setting a start and an end of a communication period and associating the communication period with the terminal, acquiring the *unique and fixed identifier* of the terminal from the terminal user information managed by the

server, and notifying the user that the communication period is ending when the communication period ends." Independent claims 16 and 22 define similar structure and relationships.

Namely, new claim 16 defines, *inter alia*, a construction machine management system comprising a plurality of terminals each having a unique and fixed terminal identifier; one terminal of the plurality of terminals being provided on one construction machine of the plurality of construction machines; and a server connected to the one terminal through a communication channel, the server comprising a database having a correspondence between the one terminal and the one construction machine based on the unique and fixed terminal identifier of the one terminal and the unique construction machine information of the one construction machine; first terminal user information unique to the one terminal; a communication period associated with the one terminal, the communication period having a start and an end; and data associating a length of the communication period with the one terminal, wherein the server monitors the one terminal and notifies a user of the terminal that the communication period is ending when the communication period ends. None of Obata, Hisano and Gray contemplates or suggests these structures and arrangements of Applicant's claims.

New claim 22 defines, *inter alia*, a construction machine; a terminal having a unique and fixed terminal identifier that is provided on the construction machine; and a server means connected to the terminal through a communication channel, the server means for managing construction machine information unique to the construction machine, managing terminal user information unique to the terminal, associating the unique and fixed terminal ~~and fixed~~ identifier with the terminal, creating a communication period with a start and an end, associating the communication period with the terminal, acquiring the unique and fixed terminal identifier of the

terminal from the terminal user information managed by the server means, and notifying a user that the communication period is ending when the communication period ends. None of Obata, Hisano and Gray contemplates or suggests these structures and arrangements of Applicant's claims.

The operation of the presently claimed invention includes managing the communication period associated with a terminal based on the unique and fixed terminal identifier, so that charges for communications during the communication period can be appropriately billed (e.g., Applicant's specification page 5, lines 7 – 13.).

None of Obata, Hisano and Gray contemplates or suggests using "unique and fixed" identifier associated with the terminal, a server managing construction machine information unique to the construction machine, managing terminal user information unique to a user of the terminal, associating the *unique and fixed identifier* with the terminal, setting a start and an end of a communication period and associating the communication period with the terminal, acquiring the *unique and fixed identifier* of the terminal from the terminal user information managed by the server, and notifying a user that the communication period is ending when the communication period ends, as required in present claims 1, 16 and 22. Namely, the teachings of Obata and Gray do not contemplate or suggest the use of a *unique and fixed* terminal identifier in association with the structure, databases and other relationships required in the present claims. The teachings of Hisano, at best, propose "temporarily" assigning an available ID for a single communication (separate from the serial number of the communication terminal), and the ID is released for re-use when the communication is over (paragraph [0038], claim 4 line 19-23), which, of course, does not contemplate or suggest the use of a *unique and fixed* terminal

identifier in association with the structure, databases and other relationships required in present claims 1, 16 and 22.

The presently claimed invention encompasses control and operation of a fleet of construction machines based upon the use of a *terminal having unique and fixed identifiers*, whereby the control, operation, cost, period of operation and other functioning of the construction machines can be controlled by, *inter alia*, a server connected to the terminal through a communication channel, the server managing construction machine information unique to the construction machine, the *unique and fixed identifier* of the terminal, setting a start and an end of a communication period and associating the communication period with the terminal, and notifying a user that the communication period is ending when the communication period ends. None of Obata, Hisano and Gray contemplates or suggests these structures and arrangements of Applicant's claims.

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the reason to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

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The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima facie* case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Where, as here, the examiner fails to establish a *prima facie* case of obviousness, the applicant has no burden to rebut the rejection of obviousness with evidence. *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The Official Action alleged that Obata discloses each of the recited elements of claim 1, but admitted that Obata does not teach or suggest the association of the communications with a particular user during the communication period. Several examples are discussed below of recited elements which are neither taught nor suggested by the references.

Neither Obata nor Hisano teach or suggest using an "unique and fixed" identifier associated with the terminal. Obata does not use the terminal identifier. Hisano, on the other hand, temporarily assigns an available ID for a single communication (separate from the serial number of the communication terminal), and the ID is released for re-use when the communication is over (paragraph [0038], claim 4 line 19-23). Hence, Hisano's temporary ID is not associated with the terminal and is certainly not *fixed* therewith.

Furthermore, neither Hisano nor Obata teach or suggest that a communication period has a start and an end, in combination with other recited elements. By using the communication period which has an actual start and end, such as required in present claims 15, 16 and 22, the

user can be notified when the communication period is ending. To the contrary, Hisano's allocated time, cited in the Office Action as being the communication period, is simply an estimated duration, e.g., 60 seconds. Hisano's user is not notified when the estimated communication duration ends, because the communication duration is merely an estimate.

For this additional reason, Hisano fails to teach or suggest the communication period for which a start and end is set. Hisano's allocated time is apparently merely "expected" and the single communication apparently can exceed the allocated time and still be associated with Hisano's identifier (paragraph [0061]). The teachings of Gray do not cure or rectify the aforesaid deficiencies in the teachings of Hisano and Obata.

Hence, Hisano and Obata, alone or in combination with Gray, fail to teach or suggest the combination of features recited in independent claim 1, when considered as a whole.

With respect to the rejected dependent claims, Applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claim 1, but also because of additional features they recite in combination.

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of

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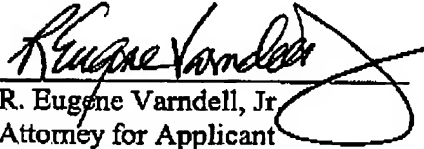
simplicity, Applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

Based on the above, Applicant respectfully submits that claims 1-4, 6, 9, 11, 13, and 15-26 are patently distinguishable from the teachings of Obata, Hisano and/or Gray within the meaning of 35 United States code §102 and 35 U.S.C. §103. Therefore, Applicant respectfully request that the Examiner reconsider and withdraw the rejections as set forth in the outstanding Office Action over these teachings.

In view of the foregoing, the Applicant submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the Examiner is invited to contact the undersigned by telephone.

In the event this paper is not timely filed, Applicant hereby petitions for an appropriate extension of time. The fee therefor, as well as any other fees which become due, may be charged to our Deposit Account No. 50-1147.

Respectfully submitted,
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